



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 10/803,349 | 03/18/2004 | Jacqueline Erlebacher | 29617/SH009A | 5816 |

4743 7590 01/05/2007
MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

| |
|----------|
| EXAMINER |
|----------|

WALCZAK, DAVID J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3751

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/05/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/803,349 | ERLEBACHER ET AL. | |
| | Examiner | Art Unit | |
| | David J. Walczak | 3751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45, 47-55, 57-78 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39 and 44 is/are allowed.
- 6) ☒ Claim(s) 45, 49-54 and 78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: In paragraph 0055, "recess 901" should be --recess 903--. The Examiner again suggests that the Applicant review the specification to correct any other errors that may be present therein. Appropriate correction is required.

Claim Objections

Claim 45 is objected to because of the following informalities: On line 3 of claim 45, "base" should be --dispenser base-- (see line 4) and on line 4, "housing" should be --dispenser housing-- (see lines 4-5). Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 73 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The newly defined recitation of the rear end of the body portion being sealed is considered to be new matter, i.e., the specification, when defining the elected embodiment, never discloses whether or not the closed end is

sealed or may including an opening to permit access to the body or enable venting of the body.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45, 49, 50 and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Connors. In regard to claim 45, Connors discloses a sheet material cartridge for use with a writing instrument comprised of a dispenser base 16 adapted for removable attachment to the writing instrument 14, a dispenser housing 12 coupled to the dispenser base defining an interior receptacle, an opening 32 in communication with the interior receptacle and sheet material comprising a plurality of sheets 18 (see column 2, lines 52-55) disposed in the housing interior receptacle wherein the sheet material has a thickness smaller than the width of the opening to allow the sheet material to pass therethrough, a nub on the base 16 (the lower threaded portion thereof) releasably engaged in a recess in the writing instrument and a recess in the rear surface of the housing 12 (through which the button extends) wherein the recess is “sized to releasably engage a nub from a writing cap”, i.e., as the writing cap and nub thereon are not considered part of the claimed combination, the recess needs only to be capable of receiving such a nub. Upon removal of the button, and upon a cap having

an appropriate size, the recess may be “sized” as claimed. Further, there is a gap between the button and the edges of the recess wherein this gap may also be “sized to releasably engage a nub from a writing cap”, depending on the size of the cap. In regard to claim 49, the housing 12 is releasably coupled to the base 16 via the threaded connection shown in Figure 2. In regard to claim 50, the interior receptacle is generally cylindrical and the sheets are arranged as a roll of sheet material. In regard to claim 78, as discussed above, Connors discloses a writing instrument body 14, a writing tip 22, a dispenser base 16 having a nub thereon wherein the nub is engaged in a recess in the rear end of the housing, a dispenser housing 12 and a roll of sheet material 18. Further, the rear end of the housing is “sealed”, i.e., elements 16, 22, 12 and the button (not numbered) all act to “seal” the rear end of the writing body 14, at least to some degree. Further, the threaded connection between base 16 and body 14 also define a “seal” at the rear end of the housing. As the Applicant has not defined the nature or degree of the “seal” at the “sealed rear end”, the Connors device is considered to have a writing instrument body portion having a “sealed rear end”.

Claims 45 and 49-53 rejected under 35 U.S.C. 102(b) as being anticipated by Ross. In regard to claim 45, Ross discloses a sheet material cartridge for use with a writing instrument comprised of a dispenser base 12 adapted for removable attachment to the writing instrument 30, a dispenser housing 24 coupled to the dispenser base defining an interior receptacle, an opening 26 in communication with the interior receptacle and sheet material comprising a plurality of sheets 18 (as individual sheets are ripped from the roll, the Ross device is considered to include a “plurality of sheets”)

disposed in the housing interior receptacle wherein the sheet material has a thickness smaller than the width of the opening to allow the sheet material to pass therethrough wherein the base 12 comprises a "nub" (the lower end of the base defines a "nub") wherein the nub is adapted to be releasably engaged in a recess in the writing instrument, i.e., as the writing instrument is not considered part of the claimed combination, the nub only needs to be capable of being received as claimed. Upon a writing instrument having an appropriately sized recess therein, the nub would be sized as claimed. Further, the housing 24 includes a rear surface having a recess therein (which receives elements 16, 17) wherein the recess is "sized to releasably engage a nub from a writing cap", i.e., as the writing cap and nub thereon are not considered part of the claimed combination, the recess needs only to be capable of receiving such a nub. Upon removal of element 16, and upon a cap having an appropriate size, the recess would be "sized" as claimed. In regard to claim 49, the housing 24 is releasably coupled to the base 12. In regard to claim 50, the interior receptacle is generally cylindrical and the sheets are arranged as a roll of sheet material. In regard to claim 51, the base includes an inner shell 11 sized for insertion into the housing and an inner surface sized to receive the roll of sheet material wherein the inner shell includes an end cover 16 attached to one end thereof and wherein the inner shell is partially cylindrical and has opposed first and second ends which define an inner slot 14 sized to receive the sheet material. In regard to claim 52, the housing opening 26 is formed as an outer slot in register with the inner slot 14 (see Figure 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53 and 54 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ross. Although the Ross reference does not disclose the specifically claimed structure of the roll of sheet material, the Examiner takes official notice that the claimed types of sheet material are commonly dispensed from housings in order to enable a user to effectively dispense sheets when needed. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that any suitable type of known sheet material, including those claimed, can be dispensed from the Ross device without effecting the overall operation thereof. It is noted that since this same "official notice" type rejection was made in the previous office action, and not contested by the Applicant in the response filed 11/3/06, this claimed feature is now considered to be admitted prior art.

Allowable Subject Matter

Claims 1, 2, 7, 9-12, 14-16, 18, 20, 21, 24, 39 and 44 allowed. It is noted that since claim 1 is no longer generic, any response to this office action attempting to place this case in condition for allowance should include a cancellation of the withdrawn claims or an indication of where the support for the claimed structure in the withdrawn claims can be found with regard to the elected embodiment.

Response to Arguments

Applicant's arguments filed 11/3/06, with respect to claims 45 and 78 have been fully considered but they are not persuasive. The Applicant contends that the cited references do not include the claimed nub structure. However, as discussed in detail above, as claim 45 is not positively claiming the cap with the nub or the writing instrument with a recess, the prior art devices need only to be capable of being used as claimed. As discussed above, the Connors and Ross device are capable of being used as claimed.

The Applicant then contends that the Connors device does not disclose a writing instrument body having a sealed end and is thereby not applicable against claim 78. However, in as much as the Applicant has disclosed the nature of the sealed end (the disclosure does not disclose such a sealed end), the writing instrument body in the Connors reference, as discussed above, is considered to have such a sealed end.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

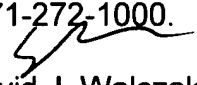
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
12/13/06

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-6,8,13,17,19,22,23,25-38,40-43,47,48,55 and 57-77.